UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/715,109	11/20/2000	Toshio Sakurai	862.1731 D2	8881

5514 7590 03/08/2006

FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

EXAMINER	
NGUYEN, VAN H	
ART UNIT	PAPER NUMBER
2194	

DATE MAILED: 03/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/715,109	SAKURAI, TOSHIO	
	Examiner	Art Unit	
	VAN H. NGUYEN	2194	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *07 December 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *30-69* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *30-69* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

WILLIAM THOMSON
SUPERVISORY PATENT EXAMINER

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *12/7/05 & 01/24/06*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This Office Action is in response to the amendment filed December 7, 2005. Claims 30-69 are pending in this application.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

The claim languages in the following claims are indefinite:

- Regarding claim 35, the phrase "a detecting step of detecting whether or not the device" renders the claim indefinite because it is unclear what is to be detected. Is the claim asserting that the existence of the device the issue, or is some operation/state associated with the device the issue to be detected?
- Regarding claim 65, it is unclear if "a device" recited at line 3 is referring to "a device" as recited at line 2.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or

improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. CIT. 1993); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); In re van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Uogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 C.F.R. ' 1.321(b) would overcome an actual or provisional rejection on this ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. ' 1.78(d).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 30–69 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of **U.S. Pat. No. 6,210,051 B1**.

Although the conflicting claims are not identical, they are not patentably distinct from each other because claims of the instant application and claims of patent'051 are both claiming an information processing apparatus which communicates with a device, comprising: detecting the device, obtaining a device ID, discriminating device driver, and warning the device driver. The claimed differences would be obvious to a programmer of ordinary skill because the instant claims are merely broader and/or alternative variations of the claims recited in patent'051.

For example, independent claim 1 of the instant application more broadly and/or alternatively claims:

"An information processing apparatus which communicates with a device via a communication medium, comprising:

a detecting unit adapted to detect the device;

an obtaining unit adapted to obtain a device ID from the device in response to a detection of the device, wherein an optional device is connected to the device and wherein the device ID is determined depending on a connection status of the optional unit to the device;

a discriminating unit adapted to discriminate whether or not a device driver for controlling the device corresponding to the obtained device ID is installed; and

a warning unit adapted to warn when said discriminating unit discriminates that the device driver corresponding to the obtained device ID is not installed in the information processing apparatus."

In contrast, claim 1 of patent'051 more narrowly and/or alternatively claims:

"An information processing apparatus connected to a device via a cable, comprising:

a detecting unit adapted to detect whether or not the cable is connected to the information processing apparatus;

an obtaining unit disposed such that when said detecting unit detects that the cable is connected to the information processing apparatus, said obtaining unit obtains a device ID of a device connected to a second end of the cable;

a first discriminating unit disposed such that when the obtaining unit obtained the device ID via the cable, said first discriminating unit discriminates whether or not a device driver being activated in the information processing apparatus at the present time is able to control the device on the basis of the obtained device ID; and

a warning unit disposed such that when said first discriminating unit discriminates that the device driver is not able to control the device, said warning unit warns that the device driver is not able to control the device."

Because the instant claims merely eliminate and/or alternatively claim limitations from the set of elements and function claimed in patent'051, such modifications would be readily apparent to a programmer of ordinary skill.

Claim Rejections - 35 USC § 103

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 30-69 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Matsuoka** in view of **Lipe et al.**

As to claim 65, Matsuoka teaches the invention substantially as claimed including an information processing apparatus (the system) which is connectable to a device (laser printer 1) via a cable (see fig.1 and the accompanying text beginning at col. 4, line 7), comprising:

a detecting (detecting) unit adapted to detect a device (see the detecting device discussion beginning at col.1, line 67; col.17, line 11; and col.18, line 46); and

an obtaining unit adapted to obtain a device ID (device are assigned ID) which the device determines to transmit to the information processing apparatus, on the basis of a type of an optional unit (optional devices) which is attached to the device (see the device ID discussion beginning at col.4, line 49 and col.15, line 49), wherein and the device ID is determined depending on a connection status (connection status) of the optional unit to the device (see the connection status and device ID discussions beginning at col.15, line 7 and figs. 12-13).

Matsuoka does teach each of the optional devices comprise a driver (col.4, lines 38-39) and determining whether or not the optional devices can be operated (col.17, lines 61-65).

Matsuoka, however, does not specifically teach a discriminating unit adapted to discriminate whether or not a device driver corresponding to the obtained device ID exists in the information apparatus.

Lipe teaches a discriminating unit adapted to discriminate whether or not a device driver corresponding to the obtained device ID exists in the information apparatus (see the Abstract; col.4, lines 60-66; col.16, lines 49-55; and col.17, lines 28-41).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Lipe with Matsuoka because Lipe's teachings would have provided the capability for preventing any conflicting use of the resources by the devices.

As to claim 66, Lipe teaches a warning unit adapted to warn when said discriminating unit discriminates that the device driver corresponding to the device does not exist in the information processing apparatus (col.10, lines 4-8).

As to claim 67, Lipe teaches a selecting unit adapted to select a device driver corresponding to the device obtained by the obtaining unit, to activate the device driver when the discriminating means discriminates that the device driver corresponding to the device exists in the information apparatus (see the device driver identification discussion beginning at col.5, line 25).

As to claim 68, the rejection of claim 65 above is incorporated herein in full. Additionally, Matsuoka further teaches the device driver and the device ID are one-to-one association (col.4, lines 38-51).

As to claim 69, the rejection of claim 65 above is incorporated herein in full. Additionally, Matsuoka further teaches the device driver and the device ID are one-to-one association (col.4, lines 38-51).

As to claim 30, the rejection of claim 65 above is incorporated herein in full. Additionally, Lipe teaches a warning unit adapted to warn when the discriminating unit discriminates that the device driver corresponding, to the obtained device ID is not installed in the information processing apparatus (indication of the absence of...driver; col.10, lines 4-11).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Lipe and Matsuoka because Lipe's teaching would have provided the capability for detecting the existence of a driver and notifying the absence of the driver to the user.

As to claim 31, Matsuoka teaches an activating unit, adapted to activate the device driver to be used (col.15, lines 49-67). Note the discussion in claim 30 above for "when the discriminating unit discriminates that the device driver corresponding to the obtained device ID is not installed."

As to claim 32, Matsuoka teaches the device is a printer (a laser printer; see the Abstract).

As to claim 33, Lipe teaches a determination unit adapted to determine whether or not device drivers, which are activated in the information processing apparatus at present (col.10, lines 4-11), are able to support a device driver corresponding to the device on the basis of determining result of the obtained device ID (col.5, lines 25-36; col.16, lines 49-55; and col.17, lines 28-40).

As to claim 34, Matsuoka teaches the determination unit determines that the device driver corresponding to the obtained device ID is not supported by the activated device drivers, the discriminating unit performs the discriminating (see fig.4B and the associated text).

As to claims 35-39, note the rejection of claims 30-34 above. Claims 35-39 are the same as claims 30-34, except claims 35-39 are method claims and claims 30-34 are apparatus claims.

As to claims 40-44, note the rejection of claims 30-34 above. Claims 40-44 are the same as claims 30-34, except claims 40-44 are computer-readable storage medium claims and claims 30-34 are apparatus claims.

As to claims 45-49, note the rejection of claims 30-34 above. Claims 45-49 are the same as claims 30-34, except claims 45-49 are computer program product claims and claims 30-34 are apparatus claims.

As to claim 50, the rejection of claim 65 above is incorporated herein in full. Additionally, Lipe teaches installing a device driver corresponding to the device ID obtained by the obtaining means, when it is determined by the first determination means that the connected device can not be supported (a device driver...identified and loaded; see the Abstract and col.9, line 20-col.10, line 3).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Lipe and Matsuoka because Lipe's teaching would have provided the capability for identifying a device driver and loading the driver to operate the device.

As to claim 51, Matsuoka teaches second determination means for determining whether or not there exists data to be printed in the information processing apparatus, when it is determined by the first determination means that the connected device can be supported and performing means for performing a printing operation on the data when it is determined by the second determination means that there exists data to be printed in the apparatus (col.3, lines 18-20 and col.15, lines 49-65).

As to claim 52, Lipe teaches third determination means for determining; whether or not a device driver corresponding to the obtained device ID is installed when it is determined by the first determination means that the connected device can not be supported, wherein the installing means installs the device driver corresponding to the obtained device ID when it is determined

by the third determination means that the device driver corresponding to the obtained device ID is installed (see the Abstract and col.9, line 20-col.10, line 3).

As to claim 53, Lipe teaches warning means for warning, when it is determined by the third determination means that the driver corresponding to the obtained device ID is not installed (col.10, lines 4-11).

As to claim 54, Matsuoka teaches the device comprises a printer (a laser printer; see the Abstract).

As to claims 55-59, note the rejection of claims 50-54 above. Claims 55-59 are the same as claims 50-54, except claims 55-59 are method claims and claims 50-54 are apparatus claims.

As to claims 60-64, note the rejection of claims 50-54 above. Claims 60-64 are the same as claims 50-54, except claims 60-64 are processing program claims and claims 50-54 are apparatus claims.

Response to Applicant's Arguments

5. Applicant's arguments filed December 7, 2005 have been fully considered but they are not persuasive.

In response to applicant's arguments regarding the Office Action's double patenting rejection, the Examiner believe that the Office Action above now provides sufficient reasoning to establish the rejection.

Applicant argues in substance that the combination of Matsouka and Lipe does not teaches an information apparatus which includes an installed a device driver and obtains a

device ID which is determined depending on a connection status of the optional device to the device. ... discriminating whether or not a device driver, corresponding to the device ID which varies according to the connection status of the optional device to the device, is installed in the information processing apparatus.

Despite Applicant's assertions, the references do teach the recited claim limitations. As shown through the mapping provided in the claim rejections, the combination of Matsouka and Lipe meets the respective recited limitations in claims 30-69 as set forth in the previous Office Action.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Contact Information

7. Any inquiry or a general nature or relating to the status of this application should be directed to the TC 2100 Group receptionist: (571) 272-2100.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to VAN H. NGUYEN whose telephone number is (571) 272-3765.

The examiner can normally be reached on Monday-Thursday from 8:30AM 6:00PM. The examiner can also be reached on alternative Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, WILLIAM THOMSON can be reached at (571) 272-3718.

The fax phone number for the organization where this application or proceeding is assigned is **(571) 273-8300.**

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to:
Commissioner for patents
P O Box 1450
Alexandria, VA 22313-1450

Van H. Nguyen

WILLIAM THOMSON
SUPERVISORY PATENT EXAMINER